

### **III. REMARKS/ARGUMENTS**

#### **A. Status of the Application**

Claims 33, 40, 43-47, 49, 53-55, 58, 61-62, 65, 106, 110, 113-121, 125, 128-132 and 134-137 are now pending. Claims 1-32, 34-39, 41-42, 48, 50-52, 56-57, 59-60, 63-64, 66-105, 107-109, 111-112, 122-124, 126-127 and 133 are cancelled. Claims 33, 106, 117, 121 and 132 are amended. Reconsideration of this application in light of the following remarks is respectfully requested.

#### **B. Independent Claims**

Claim 33 is drawn to a wellbore cement or spacer composition comprising a zeolite, a polymer and a carrier fluid. The zeolite is selected from clinoptilolite, analcime, bikitaite, brewsterite, chabazite, faujasite, harmotome, heulandite, laumontite, mesolite, natrolite, paulingite, phillipsite, scolecite, stellerite, stilbite and thomsonite. The polymer is present from about 0 to 6% by weight of dry materials and is selected from hydroxyethylcellulose, cellulose, carboxyethylcellulose, carboxymethylcellulose, carboxymethylhydroxyethylcellulose, hydroxyethylcellulose, hydroxypropylcellulose, methylhydroxypropylcellulose, methylcellulose, ethylcellulose, propylcellulose, ethylcarboxymethylcellulose, methylethylcellulose, hydroxypropylmethylcellulose, starch, guar gum, locust bean gum, tara, konjak, tamarind, karaya gum, welan gum, xanthan gum, galactomannan gums, succinoglycan gums, scleroglucan gums, tragacanth gum, arabic gum, ghatti gum, tamarind gum, carrageenan, carboxymethyl guar, hydroxypropyl guar, carboxymethylhydroxypropyl guar, polyacrylate, polymethacrylate, polyacrylamide, maleic anhydride, methylvinyl ether copolymers, polyvinyl alcohol and polyvinylpyrrolidone.

Each of claims 40-47, 49, 53-55, 58, 61-62, 65 and 135 depends directly or indirectly from claim 33, and therefore each includes at least the foregoing elements.

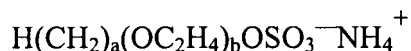
Claim 106 is drawn to a wellbore cement or spacer composition comprising a zeolite, a dispersant and a carrier fluid. The zeolite is selected from clinoptilolite, analcime, bikitaite, brewsterite, chabazite, faujasite, harmotome, heulandite, laumontite, mesolite, natrolite, paulingite, phillipsite, scolecite, stellerite, stilbite and thomsonite. The dispersant is present from

about 1 to 18% by weight of dry materials and is selected from sodium naphthalene sulfonate condensed with formaldehyde, sulfonated styrene maleic anhydride copolymer, sulfonated vinyltoluene maleic anhydride copolymer, sulfonated acetone condensed with formaldehyde, lignosulfonates and interpolymers of acrylic acid, allyloxybenzene sulfonate, allyl sulfonate and non-ionic monomers.

Each of claims 110-120 and 136 depends directly or indirectly from claim 106, and therefore each includes at least the foregoing elements.

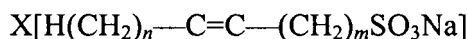
Claim 121 is drawn to a wellbore cement or spacer composition that includes a zeolite, a surfactant and a carrier fluid. The zeolite is selected from clinoptilolite, analcime, bikitaite, brewsterite, chabazite, faujasite, harmotome, heulandite, laumontite, mesolite, natrolite, paulingite, phillipsite, scolecite, stellerite, stilbite and thomsonite. The surfactant is selected from:

- (a) an ethoxylated alcohol ether sulfate of the formula:

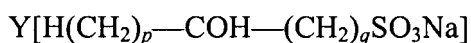


wherein a is an integer in the range of from about 6 to about 10 and b is an integer in the range of from about 3 to about 10;

- (b) a sodium salt of  $\alpha$ -olefinic sulfonic acid which is a mixture of compounds of the formulas:



and



wherein:

n and m are individually integers in the range of from about 6 to about 16;

p and q are individually integers in the range of from about 7 to about 17; and

X and Y are fractions with the sum of X and Y being 1;

- (c) a composition having the formula:



wherein:

a is an integer in the range of from about 6 to about 10;

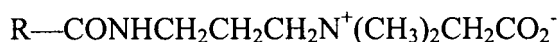
- (d) oxyalkylated sulfonate;
- (e) an alcohol ether sulfonate of the formula:



wherein:

- a is an integer in the range of from about 6 to about 10; and
- b is an integer in the range of from about 3 to about 10;

- (f) cocoamine betaine;
- (g) an alkyl or alkene amidopropyl betaine having the formula:



wherein R is a radical selected from the group of decyl, cocoyl, lauryl, cetyl and oleyl;  
and

- (h) an alkyl or alkene amidopropyl dimethylamine oxide surfactant having the formula:



wherein R is a radical selected from the group of decyl, cocoyl, lauryl, cetyl and oleyl.

Each of claims 125-132 and 137 depends directly or indirectly from claim 121, and therefore each includes at least the foregoing elements.

### **C. Rejection of Claims under 35 U.S.C. §102(b) over Kulprathipanja et al.**

Claims 33, 43-44, 47, 55 and 135 stand rejected under 35 U.S.C. § 102(b) over U.S. Patent No. 4,372,876 to Kulprathipanja et al. ("Kulprathipanja '876"). Insofar as it may be applied against the present claims, this rejection is respectfully traversed.

As provided in MPEP § 2131, "[t]o anticipate a claim, the reference must teach every element of the claim ...". Kulprathipanja '876 fails to satisfy the requirements of MPEP § 2131 because Kulprathipanja '876 does not disclose each and every element of claims 33, 43-44, 47, 55 and 135.

As noted above, the wellbore cement or spacer compositions of claims 33, 43-44, 47, 55 and 135 includes a zeolite and a polymer present from about 0 to 6% by weight of dry materials.

Kulprathipanja '876 describes an adsorbent, such as fresh clay bound Ca-Y faujasite, that is made by mixing an uncoated precursor of the adsorbent with an organic polymer such as ethyl

cellulose dissolved in a liquid organic solvent, such as methyl ethyl ketone and then removing the solvent. Kulprathipanja '876 discloses that by coating the adsorbent with ethyl cellulose the tendency of the silicon constituent of the adsorbent to dissolve in the solution resulting in the undesirable disintegration of the adsorbent is reduced.

There is no disclosure, motivation or suggestion in Kulprathipanja '876 for a downhole wellbore cement or spacer composition that includes a zeolite and a polymer present from about 0 to 6% by weight of dry materials.

In view of the foregoing, Applicants submit that Kulprathipanja '876 fails to disclose each and every element of claim 33, and therefore the rejection of claim 33 under 35 U.S.C. §102(b) should be withdrawn. Applicants further submit that the rejection of claims 43-44, 47, 55 and 135 under 35 U.S.C. §102(b) should be withdrawn for at least the same reasons that apply to claim 33.

**D. Rejection of Claims under 35 U.S.C. § 102(b) over Sirosita et al.**

Claims 33, 40, 43-44, 47, 49, 55, 58, 61, 65, 106, 110, 113-116, 120 and 135-136 stand rejected under 35 U.S.C. §102(b) over U.S. Patent No. 4,986,989 to Sirosita et al. ("Sirosita '989"). Insofar as it may be applied against the present claims, this rejection is respectfully traversed.

As provided in MPEP §2131, "[t]o anticipate a claim, the reference must teach every element of the claim ...". Sirosita '989 fails to satisfy the requirements of MPEP §2131 because Sirosita '989 does not disclose each and every element of claims 33, 40, 43-44, 47, 49, 55, 58, 61, 65, 106, 110, 113-116, 120 and 135-136.

As noted above, the wellbore cement or spacer compositions of claims 33, 40, 43-44, 47, 49, 55, 58, 61, 65, 106, 110, 113-116, 120 and 135-136 include a zeolite and either a polymer or a dispersant present from about 0 to 6% or from about 1 to 18%, respectively, by weight of dry materials.

Sirosita '989 describes an agricultural and horticultural fungicide that contains as an active ingredient at least one crystalline zeolite selected from the faujasite group, the chabazite group and the phillipsite group.

There is no disclosure, motivation or suggestion in Sirosita '989 for a downhole wellbore cement or spacer composition that includes a zeolite and either a polymer or a dispersant present from about 0 to 6% or 1 to 18%, respectively, by weight of dry materials.

In view of the foregoing, Applicants submit that Sirosita '989 fails to disclose each and every element of claims 33 and 106, and therefore the rejection of claims 33 and 106 under 35 U.S.C. §102(b) should be withdrawn. Applicants further submit that the rejection of claims 40, 43-44, 47, 49, 55, 58, 61, 65, 110, 113-116, 120 and 135-136 under 35 U.S.C. §102(b) should be withdrawn for at least the same reasons that apply to claims 33 and 106.

**E. Rejection of Claims under 35 U.S.C. §102(e) or 35 U.S.C. §103(a) over Ku**

Claims 106, 113, 114 and 136 stand rejected under 35 U.S.C. §102(e) or, in the alternative, under 35 U.S.C. §103(a) over U.S. Patent Application Publication No. 2002/0117090 to Ku. ("Ku '090"). Insofar as it may be applied against the present claims, this rejection is respectfully traversed.

In order to make a proper rejection under either 35 U.S.C. §102(e) or 35 U.S.C. §103(a), it is required that the cited reference disclose, motivate or suggest each and every element of the rejected claim. (See MPEP §2131 and MPEP §2142).

To sustain a rejection under 35 U.S.C. §103(a), MPEP §2142 further requires "some suggestion or motivation, either in the [reference itself] or in the knowledge generally available to one of ordinary skill in the art, to modify [or combine] the reference", and also that there be a "reasonable expectation of success."

In the present case, none of the criteria for sustaining a rejection over Ku '090 under either 35 U.S.C. §102(e) or 35 U.S.C. §103(a), have been satisfied with respect to any of claims 106, 113, 114 and 136.

As noted above, the downhole wellbore cement or spacer compositions of claims 106, 113, 114 and 136 include a zeolite and a dispersant present from about 1 to 18% by weight of dry materials.

Ku '090 discloses a concrete formulation for use in the construction of buildings, in which zeolite replaces at least a part of the cement that would have been used to form the concrete. (col. 1, paras. [0001], [0017]). The Examples set forth in paragraphs [0038] and

[0039] of Ku '090 include a dry mix of cement, Y-zeolite, sand and dispersant (SNF), in which the dry mix includes at most 2.85% by weight of the Y-zeolite and at most 0.2% by weight of the dispersant.

Contrary to claim 106, however, there is no disclosure, motivation or suggestion in Ku '090 for a downhole wellbore cement or spacer composition that includes a zeolite and a dispersant present from about 1 to 18% by weight of dry materials.

In view of the foregoing, Applicants respectfully submit that Ku '090 fails to disclose each and every element of claim 106, and therefore a required element of both a rejection under 35 U.S.C. §102(e) and a rejection under 35 U.S.C. §103(a) has not been met.

Further, there is no suggestion or motivation for the modification of the Ku '090 disclosure so as to provide a downhole wellbore cement or spacer composition as recited in claim 106. Neither Ku '090 nor the current Office Action describes how a person of ordinary skill in the art could be motivated to modify the disclosure of Ku '090 to provide a downhole wellbore cement or spacer composition as recited in claim 106. Further, there could be no reasonable expectation of success of providing such a downhole wellbore cement or spacer composition from the disclosure of Ku '090 for at least the reason that there is no suggestion or motivation for modification of the disclosure of Ku '090. Moreover, a reasonable expectation of success for modifying a concrete formulation as described by Ku '090 to provide a downhole wellbore cement or spacer composition as recited in claim 106 has not been provided. Accordingly, Applicants submit that Ku '090 fails to satisfy the remaining requirements of a rejection of claim 106 under 35 U.S.C. §103(a).

In view of the foregoing, Applicants respectfully submit that none of the criteria for sustaining a rejection under either 35 U.S.C. §102(e) or 35 U.S.C. §103(a) have been satisfied with respect to claim 106. Moreover, none of the criteria for sustaining a rejection under either 35 U.S.C. §102(e) or 35 U.S.C. §103(a) have been satisfied with respect to claims 113-114 and 136 for at least the same reasons that apply to claim 106. For the foregoing reasons, Applicants submit that the rejection of claims 106, 113-114 and 136 under 35 U.S.C. § 102(e) or 35 U.S.C. §103(a) over Ku '090 should be withdrawn.

**F. Rejection of Claims under 35 U.S.C. §103(a) over Chaux ‘734**

Claims 33, 40-47, 49, 53-55, 58, 61-62, 65, 106, 110-121 and 125-137 stand rejected under 35 U.S.C. §103(a) over U.S. Patent No. 4,548,734 to Chaux (“Chaux ‘734). As noted above, claim 133 is cancelled. Insofar as it may be applied against the present claims, this rejection is respectfully traversed.

In order to make a proper rejection under 35 U.S.C. §103(a), it is required that the cited reference disclose, motivate or suggest each and every element of the rejected claims. (See MPEP §2142). MPEP §2142 further requires “some suggestion or motivation, either in the [reference itself] or in the knowledge generally available to one of ordinary skill in the art, to modify [or combine] the reference”, and also that there be a “reasonable expectation of success.”

In the present case, none of the criteria for sustaining a rejection over Chaux ‘734 under 35 U.S.C. §103(a), have been satisfied with respect to any of claims 33, 40-47, 49, 53-55, 58, 61-62, 65, 106, 110-121, 125-132 and 134-137.

As noted above, the downhole wellbore cement or spacer compositions of claims 33, 40-47, 49, 53-55, 58, 61-62, 65, 106, 110-121, 125-132 and 134-137 include a zeolite. In the case of the downhole wellbore cement or spacer compositions of claims 33, 40-47, 49, 53-55, 58, 61-62, 65, 106, 110-120 and 135-136, the composition further includes either a polymer or a dispersant present from about 0 to 6% or from about 1 to 18%, respectively, by weight of dry materials. In the case of the downhole wellbore cement or spacer compositions of claims 121, 125-132 and 137, the downhole wellbore cement or spacer compositions further include a surfactant.

Chaux ‘734 discloses a composition that includes a water soluble gum or polymer, a water donor material and optionally an anionic or nonionic surfactant (column 8, lines 37-44). According to Chaux ‘734 the water donor material, which can be a zeolite, is impregnated with water and the water-impregnated water donor material is mixed in a dry state with the gum and optionally the anionic or nonionic surfactant (column 11, lines 56-68). Chaux ‘734 also discloses that the “dry materials” include 30 to 70% by weight of the water soluble gum, 7 to 40% by weight of the water donor, and 0 to 10% by weight of the anionic or nonionic surfactant.

Contrary to claims 33, 106 and 121, however, there is no disclosure, motivation or suggestion in Chaux ‘734 for a downhole wellbore cement or spacer composition that includes a

zeolite and, (a) either a polymer or a dispersant present from about 0 to 6% or from about 1 to 18%, respectively, by weight of dry materials, or (b) a surfactant.

In view of the foregoing, Applicants respectfully submit that Chaux '734 fails to disclose each and every element of claims 33, 106 and 121, and therefore a required element of a rejection under 35 U.S.C. §103(a) has not been met.

Further, there is no suggestion or motivation for the modification of Chaux '734 so as to provide a downhole wellbore cement or spacer composition as recited in any of claims 33, 106 or 121. Neither Chaux '734 nor the current Office Action describes how a person of ordinary skill in the art could be motivated to modify the disclosure of Chaux '734 to provide a downhole wellbore cement or spacer composition as recited in any of claims 33, 106 or 121. Further, there could be no reasonable expectation of success of providing such a downhole wellbore cement or spacer composition from the disclosure of Chaux '734 for at least the reason that there is no suggestion or motivation for modification of the disclosure of Chaux '734. Moreover, a reasonable expectation of success for modifying the formulation as described by Chaux '734 to provide a downhole wellbore cement or spacer composition as recited in any of claims 33, 106 or 121 has not been provided. Accordingly, Applicants submit that Chaux '734 fails to satisfy the remaining requirements of a rejection of claim 33, 106 or 121 under 35 U.S.C. §103(a).

In view of the foregoing, Applicants respectfully submit that none of the criteria for sustaining a rejection under 35 U.S.C. §103(a) have been satisfied with respect to claims 33, 106, or 121. Moreover, none of the criteria for sustaining a rejection under 35 U.S.C. §103(a) have been satisfied with respect to claims 40-47, 49, 53-55, 58, 61-62, 65, 110-120, 125-132 and 134-137 for at least the same reasons that apply to claims 33, 106 and 121. For the foregoing reasons, Applicants submit that the rejection of claims 33, 40-47, 49, 53-55, 58, 61-62, 65, 106, 110-121, 125-132 and 134-137 under 35 U.S.C. §103(a) over Chaux '734 should be withdrawn.

**G. Rejection of Claims under 35 U.S.C. §103(a) over Sobolev '108 in view of Ku '090**

Claims 33, 41-47, 53-55, 58, 106, 113-115, 117 and 135-136 stand rejected under 35 U.S.C. §103(a) over International Patent Application Publication No. WO 98/54108 to Sobolev



et al. (“Sobolev ‘108”) in view of Ku ‘090. Insofar as it may be applied against the present claims, this rejection is respectfully traversed.

In order to make a proper rejection under 35 U.S.C. §103(a), it is required that the cited references disclose, motivate or suggest each and every element of the rejected claims. (See MPEP §2142). MPEP §2142 further requires “some suggestion or motivation, either in the [reference itself] or in the knowledge generally available to one of ordinary skill in the art, to modify [or combine] the reference”, and also that there be a “reasonable expectation of success.”

In the present case, none of the criteria for sustaining a rejection over Sobolev ‘108 in view of Ku ‘090 under 35 U.S.C. §103(a), have been satisfied with respect to any of claims 33, 41-47, 53-55, 58, 106, 113-115, 117 and 135-136.

As noted above, the downhole wellbore cement or spacer compositions of claims 33, 41-47, 53-55, 58, 106, 113-115, 117 and 135-136 include a zeolite and either a polymer or a dispersant present from about 0 to 6% or from about 1 to 18%, respectively, by weight of dry materials.

Sobolev ‘108 discloses an admixture for a cement system. (Abstract.) The admixture consists of a water reducer solution and a sorbent, which must be a fine alkali reactive silica dioxide based material. (page 3, lines 30 – 31). In certain examples, the sorbent could be zeolite. (page 3, line 33).

Contrary to claims 33 and 106, however, there is no disclosure, motivation or suggestion in Sobolev ‘108 for a downhole wellbore cement or spacer composition that includes a zeolite and either a polymer or a dispersant present from about 0 to about 6% or from about 1 to 18%, respectively, by weight of dry materials.

As noted above, Ku ‘090 discloses a concrete formulation for use in the construction of buildings, in which zeolite replaces at least a part of the cement that would have been used to form the concrete. (col. 1, paras. [0001], [0017]).

Contrary to claims 33 and 106, however, there is no disclosure, motivation or suggestion in Ku ‘090 for a downhole wellbore cement or spacer composition that includes a zeolite and either a polymer or a dispersant present from about 0 to about 6% or from about 1 to 18%, respectively, by weight of dry materials.

In view of the foregoing, Applicants respectfully submit that both of Sobolev '108 and Ku '090 fail to disclose each and every element of claims 33 and 106, and therefore a required element of a rejection under 35 U.S.C. §103(a) has not been met.

Further, Sobolev '108 and Ku '090 fail to suggest or motivate a modification of the respective disclosures so as to provide a downhole wellbore cement or spacer composition as recited in either claim 33 or 106. None of Sobolev '108, Ku '090 and the current Office Action describe how a person of ordinary skill in the art could be motivated to modify the cement admixture described by Sobolev '108 or the concrete formulation described by Ku '090 to provide a downhole wellbore cement or spacer composition as recited in claims 33 and 106. Further, there could be no reasonable expectation of success of providing such a downhole wellbore cement or spacer composition from the disclosures of Sobolev '108 and Ku '090 for at least the reason that there is no suggestion or motivation for modification of the disclosures of Sobolev '108 and Ku '090. Moreover, a reasonable expectation of success for modifying an additive for a cement or concrete composition to provide a downhole wellbore cement or spacer composition as recited in claims 33 and 106 has not been provided. Accordingly, Applicants submit that Sobolev '108 and Ku '090 fail to satisfy the remaining requirements of a rejection of claims 33 or 106 under 35 U.S.C. §103(a).

In view of the foregoing, Applicants respectfully submit that none of the criteria for sustaining a rejection under 35 U.S.C. §103(a) have been satisfied with respect to claims 33 or 106. Moreover, none of the criteria for sustaining a rejection under 35 U.S.C. §103(a) have been satisfied with respect to claims 41-47, 53-55, 58, 113-115, 117 and 135-136 for at least the same reasons that apply to claims 33 and 106. For the foregoing reasons, Applicants submit that the rejection of claims 33, 41-47, 53-55, 58, 106, 113-115, 117 and 135-136 under 35 U.S.C. §103(a) over Sobolev '108 in view of Ku '090 should be withdrawn.

**H. Rejection of Claims under 35 U.S.C. §103(a) over Ku ‘090 in view of Roddy ‘524 or Chatterji ‘489**

Claims 33, 61-62, 106, 111-114, 118-119, 121, 125-132 and 134-137 stand rejected under 35 U.S.C. §103(a) over Ku ‘090 in view of U.S. Patent No. 6,457,524 to Roddy (“Roddy ‘524”) and U.S. Patent No. 5,888,489 to Chatterji et al. (“Chatterji ‘489”). Insofar as it may be applied against the present claims, this rejection is respectfully traversed.

As noted above, the downhole wellbore cement or spacer compositions of claims 33, 61-62, 106, 111-114, 118-119, 121, 125-132 and 134-137 include a zeolite. In the case of the downhole wellbore cement or spacer compositions of claims 33, 61-62, 106, 111-114, 118-119 and 135-136, the composition further includes either a polymer or a dispersant present from about 0 to 6% or from about 1 to 18%, respectively, by weight of dry materials. In the case of the downhole wellbore cement or spacer compositions of claims 121, 125-132 and 137, the downhole wellbore cement or spacer compositions further include a surfactant.

Also as noted above, Ku ‘090 discloses a concrete formulation for use in the construction of buildings, in which zeolite replaces at least a part of the cement that would have been used to form the concrete. (col. 1, paras. [0001], [0017]).

Contrary to claims 33, 106 and 121, however, there is no disclosure, motivation or suggestion in Ku ‘090 for a downhole wellbore cement or spacer composition that includes a zeolite and (a) either a polymer or a dispersant present from about 0 to about 6% or from about 1 to 18%, respectively, by weight of the dry material, or (b) a surfactant.

Roddy ‘254 discloses cement compositions that include cement and a flow enhancing additive, and methods for the use of such compositions. The flow enhancing additive is a particulate solid material with a flow inducing polar chemical absorbed thereon. In one example, the particulate solid material can be zeolite, and the zeolite carries the flow inducing polar chemical. (Col. 4, lines 38 – 42).

Contrary to claims 33, 106 and 121, however, there is no disclosure, motivation or suggestion in Roddy ‘254 for a downhole wellbore cement or spacer composition that includes a zeolite and (a) either a polymer or a dispersant present from about 0 to about 6% or from about 1 to 18%, respectively, by weight of dry materials, or (b) a surfactant.

Chatterji '489 discloses lightweight well cement compositions that include slag cement, water to form a pumpable slurry, gas to foam the cement slurry and a foaming agent.

Contrary to claims 33, 106 and 121, however, there is no disclosure, motivation or suggestion in Chatterji '489 for a downhole wellbore cement or spacer composition that includes a zeolite and (a) either a polymer or a dispersant present from about 0 to about 6% or from about 1 to 18%, respectively, by weight of dry materials, or (b) a surfactant.

In order to make a proper rejection under 35 U.S.C. §103(a), it is required that the cited references disclose, motivate or suggest each and every element of the rejected claims. (See MPEP §2142). MPEP §2142 further requires "some suggestion or motivation, either in the [reference itself] or in the knowledge generally available to one of ordinary skill in the art, to modify [or combine] the reference", and also that there be a "reasonable expectation of success."

In the present case, none of the criteria for sustaining a rejection over Ku '090 in view of Roddy '254 and Chatterji '489 under 35 U.S.C. §103(a), have been satisfied with respect to any of claims 33, 61-62, 106, 111-114, 118-119, 121, 125-132 and 134-137.

Specifically, there is no disclosure, motivation or suggestion in any of Ku '090, Roddy '254 and Chatterji '489 for a downhole wellbore cement or spacer composition that includes a zeolite and (a) either a polymer or a dispersant present from about 0 to about 6% or from about 1 to 18%, respectively, by weight of dry materials, or (b) a surfactant.

In view of the foregoing, Applicants respectfully submit that each of Ku '090, Roddy '254 and Chatterji '489 fail to disclose each and every element of claims 33, 106 and 121, and therefore a required element of a rejection under 35 U.S.C. §103(a) has not been met.

Further, each of Ku '090, Roddy '254 and Chatterji '489 fail to suggest or motivate a modification of the respective disclosures so as to provide a downhole wellbore cement or spacer composition as recited in any of claims 33, 106 or 121. None of Ku '090, Roddy '254, Chatterji '489 and the current Office Action describe how a person of ordinary skill in the art could be motivated to modify the cement and concrete compositions described by Ku '090, Roddy '254 and Chatterji '489 to provide a downhole wellbore cement or spacer composition as recited in claims 33, 106 and 121. Further, there could be no reasonable expectation of success of providing such a downhole wellbore cement or spacer composition from the disclosures of Ku '090, Roddy '254 and Chatterji '489 for at least the reason that there is no suggestion or

motivation for modification of the disclosures of Ku '090, Roddy '254 and Chatterji '489. Moreover, a reasonable expectation of success for modifying an additive for the cement or concrete compositions of Ku '090, Roddy '254 and Chatterji '489 to provide a downhole wellbore cement or spacer composition as recited in claims 33, 106 and 121 has not been provided. Accordingly, Applicants submit that Ku '090, Roddy '254 and Chatterji '489 fail to satisfy the remaining requirements of a rejection of claims 33, 106 or 121 under 35 U.S.C. §103(a).

In view of the foregoing, Applicants respectfully submit that none of the criteria for sustaining a rejection under 35 U.S.C. §103(a) have been satisfied with respect to claims 33, 106 or 121. Moreover, none of the criteria for sustaining a rejection under 35 U.S.C. §103(a) have been satisfied with respect to claims 61-62, 111-114, 118-119, 125-132 and 134-137 for at least the same reasons that apply to claims 33, 106 and 121. For the foregoing reasons, Applicants submit that the rejection of claims 33, 61-62, 106, 111-114, 118-119, 121, 125-132 and 134-137 under 35 U.S.C. §103(a) over Ku '090 in view of Roddy '254 and Chatterji '489 should be withdrawn.

**I. Obviousness-type Double Patenting Rejection over Patent No. 6,898,057**

Claims 106, 110, 113-114, 120 and 136 stand rejected under the judicially created doctrine of obviousness-type double patenting over claims 1, 2, 9, 12-15, 18-19, 26, 29-32, 35 and 40-43 of U.S. Patent No. 6,898,057 ("the '057 patent"), formerly U.S. Patent Application No. 10/315,415. This rejection is respectfully traversed.

As noted above, the downhole wellbore cement or spacer compositions of claims 106, 110, 113-114, 120 and 136 include a zeolite and a dispersant present from about 1 to 18% by weight of dry materials.

Claims 1, 2, 9, 12-15, 18-19, 26, 29-32, 35 and 40-43 of the '057 patent are directed to methods of performing cementing operations that include preparing a cement composition, placing the cement composition in a subterranean zone, and allowing the cement composition to set therein.

Contrary to claims 106, 110, 113-114, 120 and 136, however, there is no disclosure, motivation or suggestion in any of claims 1, 2, 9, 12-15, 18-19, 26, 29-32, 35 and 40-43 of the

'057 patent for a downhole wellbore cement or spacer composition that includes a zeolite and a dispersant present from about 1 to about 18% by weight of dry materials.

There is also no disclosure, motivation or suggestion in the '057 patent for modifying the cementing composition recited in claims 1, 2, 9, 12-15, 18-19, 26, 29-32, 35 and 40-43 of the '057 patent to correspond to a downhole wellbore cement or spacer composition as described in claims 106, 110, 113-114, 120 and 136.

In view of the foregoing, Applicants respectfully request that the obviousness-type double patenting rejection of claims 106, 110, 113-114, 120 and 136 over claims 1, 2, 9, 12-15, 18-19, 26, 29-32, 35 and 40-43 of the '057 patent be withdrawn.

**J. Obviousness-type Double Patenting Rejection over Application No. 10/795,158**

Claims 33, 40-47, 49, 53-55, 58, 106, 110-117, 120, 135 and 136 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 5-12 and 14-31 of copending Application No. 10/795,158 ("the '158 application"). This rejection is respectfully traversed.

In the event that the Examiner maintains the provisional obviousness-type double patenting rejection in this application, Applicants request that at such time that the provisional obviousness-type double patenting rejection is the only rejection remaining in this application, that the Examiner follow the direction provided in MPEP § 804. MPEP § 804, p. 800-17.

As noted above, the downhole wellbore cement or spacer compositions of claims 33, 40-47, 49, 53-55, 58, 106, 110-117, 120 and 135-136 include a zeolite and either a polymer or a dispersant present from about 0 to 6% or from about 1 to 18%, respectively, by weight of dry materials.

Claims 1, 5-12 and 14-31 of the '158 application are directed to methods of performing drilling operations including circulating a drilling fluid composition.

Contrary to claims 33, 40-47, 49, 53-55, 58, 106, 110-117, 120 and 135-136 of this application, there is no disclosure, motivation or suggestion in any of claims 1, 5-12 and 14-31 of the '158 application for a downhole wellbore cement or spacer composition that includes a zeolite and either a polymer or a dispersant present from about 0 to about 6% or from about 1 to 18%, respectively, by weight of dry materials.

There is also no disclosure, motivation or suggestion in the '158 application for modifying the drilling fluid composition used in the methods recited in claims 1, 5-12 and 14-31 of the '158 application to correspond to a downhole wellbore cement or spacer composition as described in claims 33, 40-47, 49, 53-55, 58, 106, 110-117, 120 and 135-136.

In view of the foregoing, Applicants respectfully request that the provisional obviousness-type double patenting rejection of claims 33, 40-47, 49, 53-55, 58, 106, 110-117, 120 and 135-136 over claims 1, 5-12 and 14-31 of the '158 application be withdrawn.

**K. Obviousness-type Double Patenting Rejection over Application No. 10/816,034**

Claims 33, 40-47, 53-55, 65 and 135 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3, 9, 14-23, 27-28, 96, 98, 101-105, 108-110, 112, 117-121 and 124-125 of copending Application No. 10/816,034 ("the '034 application"). This rejection is respectfully traversed.

In the event that the Examiner maintains the provisional obviousness-type double patenting rejection in this application, Applicants request that at such time that the provisional obviousness-type double patenting rejection is the only rejection remaining in this application, that the Examiner follow the direction provided in MPEP § 804. MPEP § 804, p. 800-17.

As noted above, the downhole wellbore cement or spacer compositions of claims 33, 40-47, 53-55, 65 and 135 include a zeolite and a polymer present from about 0 to about 6% by weight of dry materials.

Claims 1, 3, 9, 14-23, 27-28, 96, 98, 101-105, 108-110, 112, 117-121 and 124-125 of the '034 application are directed to methods of cementing in a subterranean zone that include preparing a cement composition, placing the cement composition in the subterranean zone, and allowing the cement composition to set therein.

Contrary to claims 33, 40-47, 53-55, 65 and 135 of the present application, there is no disclosure, motivation or suggestion in any of claims 1, 3, 9, 14-23, 27-28, 96, 98, 101-105, 108-110, 112, 117-121 and 124-125 of the '034 application for a downhole wellbore cement or spacer composition that includes a zeolite and a polymer present from about 0 to about 6% by weight of dry materials.

There is also no disclosure, motivation or suggestion in the '034 application for modifying the cementing composition recited in claims 1, 3, 9, 14-23, 27-28, 96, 98, 101-105, 108-110, 112, 117-121 and 124-125 of the '034 application to correspond to a downhole wellbore cement or spacer composition as described in claims 33, 40-47, 53-55, 65 and 135.

In view of the foregoing, Applicants respectfully request that the provisional obviousness-type double patenting rejection of claims 33, 40-47, 53-55, 65 and 135 over claims 1, 3, 9, 14-23, 27-28, 96, 98, 101-105, 108-110, 112, 117-121 and 124-125 of the '034 application be withdrawn.

**L. Obviousness-type Double Patenting Rejection over Application No. 11/126,626**

Claims 33, 40-44, 49, 53-55 and 135 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3, 10 and 16-17 of copending Application No. 11/126,626 ("the '626 application"). Insofar as it may be applied against the pending claims, this rejection is respectfully traversed.

In the event that the Examiner maintains the provisional obviousness-type double patenting rejection in this application, Applicants request that at such time that the provisional obviousness-type double patenting rejection is the only rejection remaining in this application, that the Examiner follow the direction provided in MPEP § 804. MPEP § 804, p. 800-17.

As noted above, the downhole wellbore cement or spacer compositions of claims 33, 40-44, 49, 53-55 and 135 include a zeolite and a polymer present from about 0 to about 6% by weight of dry materials.

Claims 1, 3, 10 and 16-17 of the '626 application are directed to cement compositions that include at least one cementitious material, zeolite and a mixing fluid.

Contrary to claims 33, 40-44, 49, 53-55 and 135 of the present application, there is no disclosure, motivation or suggestion in any of claims 1, 3, 10 and 16-17 of the '626 application for a downhole wellbore cement or spacer composition that includes a zeolite and a polymer present from about 0 to about 6% by weight of dry materials.

There is also no disclosure, motivation or suggestion in the '626 application for modifying the cementing composition recited in claims 1, 3, 10 and 16-17 of the '626 application



to correspond to a downhole wellbore cement or spacer composition as described in claims 33, 40-44, 49, 53-55 and 135.

In view of the foregoing, Applicants respectfully request that the provisional obviousness-type double patenting rejection of claims 33, 40-44, 49, 53-55 and 135 over claims 1, 3, 10 and 16-17 of the '626 application be withdrawn.

**M. Obviousness-type Double Patenting Rejection over Application No. 11/270,307**

Claims 33, 40-46, 53-55, 58, 65, 106, 110-114, 117, 120 and 135-136 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 4-5, 10-16, 20-26 and 30 of copending Application No. 11/270,307 ("the '307 application"). Insofar as it may be applied against the present claims, this rejection is respectfully traversed.

In the event that the Examiner maintains the provisional obviousness-type double patenting rejection in this application, Applicants request that at such time that the provisional obviousness-type double patenting rejection is the only rejection remaining in this application, that the Examiner follow the direction provided in MPEP § 804. MPEP § 804, p. 800-17.

As noted above, the downhole wellbore cement or spacer compositions of claims 33, 40-46, 53-55, 58, 65, 106, 110-114, 117, 120 and 135-136 includes a zeolite and either a polymer or a dispersant present from about 0 to 6% or from about 1 to 18%, respectively, by weight of dry materials.

Claims 1, 4-5, 10-16, 20-26 and 30 of the '307 application are directed to methods of performing cementing operations including circulating a drilling fluid composition and mixing a cementitious material with an amount of the drilling fluid to form a cementing composition as well as to cementing compositions that include a cementitious material and a drilling fluid.

Contrary to the subject matter of claims 33, 40-46, 53-55, 58, 65, 106, 110-114, 117, 120 and 135-136 of this application, there is no disclosure, motivation or suggestion in any of claims 1, 4-5, 10-16, 20-26 and 30 of the '307 application for a downhole wellbore cement or spacer composition that includes a zeolite and either a polymer or a dispersant present from about 0 to 6% or from about 1 to 18%, respectively, by weight of dry materials.

There is also no disclosure, motivation or suggestion in the '307 application for modifying the cementing compositions recited in claims 1, 4-5, 10-16, 20-26 and 30 of the '307 application to correspond to a downhole wellbore cement or spacer composition as described in claims 33, 40-46, 53-55, 58, 65, 106, 110-114, 117, 120 and 135-136.

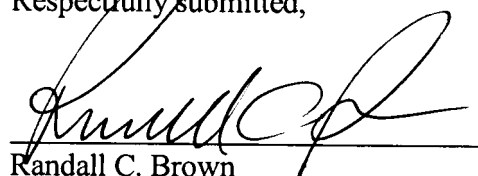
In view of the foregoing, Applicants respectfully request that the provisional obviousness-type double patenting rejection of claims 33, 40-46, 53-55, 58, 65, 106, 110-114, 117, 120 and 135-136 over claims 1, 4-5, 10-16, 20-26 and 30 of the '307 application be withdrawn.

**N. Conclusion**

Claims 33, 40-47, 49, 53-55, 58, 61-62, 65, 106, 110-121, 125-132 and 134-137 are now pending. In view of the foregoing remarks, allowance of claims 33, 40-47, 49, 53-55, 58, 61-62, 65, 106, 110-121, 125-132 and 134-137 is respectfully requested. The examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

Date: 11/27/06

Respectfully submitted,

  
Randall C. Brown  
Registration No. 31,213

HAYNES AND BOONE, LLP  
901 Main Street, Suite 3100  
Dallas, Texas 75202 3789  
Telephone: 214-651-5242  
Facsimile: 214-200-0853  
E-Mail: [ipdocketing@haynesboone.com](mailto:ipdocketing@haynesboone.com)